

REMARKS

I. Status of the Claims

This Amendment is being submitted in response to the Office Action dated November 19, 2008 in the above-identified application. Concurrently with this Amendment, Applicant submits a petition for a one-month extension of time for filing a response, along with the requisite fee. Therefore the time for filing a response to the November 19, 2008 Office Action is thereby extended to March 19, 2009, and this Amendment is being timely filed. If it is determined that any additional fee is due in connection with this filing, the Commissioner is authorized to charge said fees to Deposit Account No. 50-0552.

Claims 29, 31 to 34, 36 and 37 have been amended without prejudice. Support for these amendments can be found, for example, on page 5, lines 7 to 13, and page 25, lines 9 to 18 of the specification as filed and in paragraphs [0022] and [0156] of U.S. Publication No. 2008/0153104 of the present specification.

Claims 1 to 28 were previously canceled without prejudice via preliminary amendment dated October 10, 2006.

Claims 29 and 37 are now pending.

Applicants respectfully submit that no new matter has been added by virtue of this amendment.

II. Objections to the Specification

In the present Office Action, the disclosure was objected to for informalities. Specifically, the disclosure was objected to because it contained an embedded hyperlink and/or other form of browser-executable code.

By way of the present amendment, Applicants have deleted the embedded hyperlink and/or other form of browser-executable code found at paragraphs [0192] and [0228] of U.S. Publication No. 2008/0153104 of the present specification or page 39, line 19 and page 50, line 14 of the present specification as originally filed.

In view of the foregoing, the objection to the specification is now moot and the Applicant respectfully requests withdrawal of the objection to the specification.

III. Claim Rejections- 35 USC §112

Claims 29 to 37 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner asserted that “the specification does not provide SEQ ID NOs that correspond to the species listed other than human or any identifying characteristics. Office Action, page 3, third full paragraph. The Examiner also stated “[o]nly human C20orf102 (SEQ ID NOs: 2 and 66), but not the full breadth of the claim(s) meet the written description requirement provision of 35 USC § 112, first paragraph. See Office Action, page 5, lines 20 to 22.

Claims 29 to 37 were also rejected under 35 U.S.C. § 112, first paragraph, on the grounds of enablement. Specifically, the Examiner stated “the specification, while being enabling for a method of diagnosing cancer comprising detecting human C20orf102 protein in a human subject (detecting DEQ ID NO:66), does not reasonably provide enablement for a method of diagnosing cancer comprising detecting other species of C20orf102 protein (i.e. dog, cat, mouse, hamster).” See Office Action, page 6, lines 5 to 10.

Solely to expedite the prosecution of this application, the applicants have amended claims 29 to 37 to recite “human C20orf102 protein” which the Examiner has admitted meets both the written description requirement provision of 35 USC § 112, first paragraph and the enablement requirement of 35 USC § 112, first paragraph.

For the foregoing reasons, withdrawal of the rejection to claims 29 to 37 under 35 U.S.C. § 112, first paragraph is respectfully requested.

IV. Claim Rejections- 35 USC §102

In the Office Action, the Examiner rejected claims 29 to 32, 34, 36 and 37 under 35 U.S.C. 102(b) as being anticipated by Yue et al. (WO/2002/026982).

Applicants respectfully submit that the Yue reference discloses 67 molecules which are useful in treatment of more than 220 diseases (but not limited to the more than 220 diseases disclosed therein). The Yue reference lists more than 14740 combinations of molecules and diseases in total. Applicants respectfully submit that the Yue reference only discloses a genus invention in a comprehensive manner but fails to provide sufficiently specified or described combinations of the species invention as claimed in the subject application.

Furthermore, the Yue reference discloses that the polypeptide of SEQ ID NO: 3 and the polynucleotide of SEQ ID NO:70 were derived from a library of RNA isolated from brain tissue from BRAINOT09 male fetus (see Tables 5 and 6). The Yue reference only discloses that the polypeptide of SEQ ID NO:3 (page 33) shows a local homology of 51% with a mouse transmembrane protein (GenBank ID g7259265), and that the polypeptide is a secreted protein. However, the Yue reference does not mention a possible relationship between the specific gene and any type of cancer.

Therefore, Applicants submit that the Yue et al. reference does not show or teach a “method of diagnosing cancer comprising detecting human C20orf102 protein” as recited in claim 29. The Yue reference also does not show or teach “a method of diagnosing cancer comprising the steps of: (a) collecting a sample from a subject; and (b) detecting human C20orf102 protein contained in the collected sample” as recited in claim 34.

Accordingly, independent claims 29 and 34 are not anticipated by the Yue et al. reference.

For the foregoing reasons, withdrawal of the rejection under 35 U.S.C. § 102(b) to claims 29 and 34, as well as, dependent claims to 30 to 32, 36 and 37 is respectfully requested.

V. Claim Rejections- 35 USC §103

In the Office Action, the Examiner rejected claims 29 to 37 under 35 U.S.C. 103(a) as being obvious over Yue et al. (WO/2002/026982) in view of Ruben et al. (U.S. Patent 7,169,565).

In the Office Action, the Examiner alleged that “it would have been *prima facie* obvious to one of ordinary skill in the art at the time the claimed invention was made to perform the method taught by Yue et al. of determining the presence of C20orf102 protein using an antibody in samples such as blood, plasma or serum from a subject as taught by Ruben et al.” See Office Action, page 11, lines 9 to 13.

As admitted in the Office Action, “Yue et al. does not teach a sample from a subject comprising blood, serum or plasma.” See Office Action, page 11, lines 2-3. The Yue reference discloses that the polypeptide of SEQ ID NO:3 shows a local homology of 51% with a mouse transmembrane protein (GenBank ID g7259265). See Yue, page 33m, lines 9-10. Therefore, Applicants respectfully submit that the Yue reference teaches that C20orf102 protein has a local homology of 51% with a transmembrane protein and is anchored on the cell surface.

In view of the inherent nature of the molecule described in the Yue reference, there is no reason for a person of skill in the art to combine the C20orf102 protein anchored on the cell surface as disclosed in the Yue reference with the method for detection of a molecule in blood, plasma or serum as described in Ruben et al. Even if the Ruben et al. patent discloses a method for detection of a protein in a blood, plasma or serum sample, a person skilled in the art has no reason to combine the C20orf102 protein anchored on the cell surface as disclosed in the Yue et al. reference with the Ruben et al. patent to achieve the present invention.

U.S. Patent Application 10/568,471
Response to Office Action dated November 19, 2008
Amendment dated April 9, 2009

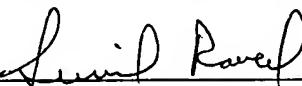
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For the foregoing reasons, withdrawal of the rejection to claims 29 to 37 under 35 U.S.C. § 103(a) is respectfully requested.

Conclusion

An early and favorable action on the merits is earnestly solicited. According to currently recommended Patent Office policy, the Examiner is requested to contact the undersigned in the event that a telephonic interview will advance the prosecution of this application.

Respectfully submitted,
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